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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/539,407	01/17/2006	Laurent Meijer	040388-0131	4591

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EXAMINER	
SCHUBERG, LAURA J	
ART UNIT	PAPER NUMBER
1657	

MAIL DATE	DELIVERY MODE
07/05/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No. 10/539,407	Applicant(s) MEIJER ET AL.	
	Examiner Laura Schuberg	Art Unit 1657	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 June 2007 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:
   a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
   b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

   Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).
4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *1,3-9 and 11-14*.
   Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08) Paper No(s).._____
13. ☐ Other: _____.

Leon B Lankford, Jr.
Primary Examiner
Art Unit 1651

Continuation of 5. Applicant's reply has overcome the following rejection(s): 35 USC 102(b) over Lowenheim (WO 99/42088), 35 USC 102(e) over Li et al.(US 2002/0151491) and 35 USC 102(e) over Nicotera et al. (US 2004/0019015).

Continuation of 11. does NOT place the application in condition for allowance because: Claims 1, 3-9 and 11-14 remain rejected under 35 USC 103(a) as being unpatentable over Meijer (WO 01/41768 A2) in view of Nicotera et al. (US 2004/0019015 A1) and Schaefer et al. (US 6,096,873).
Applicant's arguments filed 06/05/2007 have been fully considered but they are not persuasive.

Applicant argues that the claimed method is directed to treating deafness by administering a purine-derivative kinase inhibitor to induce cell differentiation. Applicant argues that Meijer teaches the use of hymenialdisine in treating neurodegenerative diseases by preventing cell death and that since cell differentiation is entirely different from cell death, that the skilled person would not have considered it obvious to come up with the claimed method based on the teaching of Meijer. This is not found persuasive because the fact that applicant has recognized another advantage which would flow naturally from following the suggestion of the prior art cannot be the basis for patentability when the differences would otherwise be obvious. See Ex parte Obiaya, 227 USPQ 58, 60 (Bd. Pat. App. & Inter. 1985). Artisans of ordinary skill may not recognize the inherent characteristics or functioning of the prior art. However, the discovery of a previously unappreciated property of a prior art composition or method, or of a scientific explanation for the prior art's functioning, does not render the old composition or method patentably new to the discoverer. Since Meijer was teaching the treatment of neurodegenerative diseases with the administration of the same protein kinase inhibitors as claimed by Applicant, the inherent effects of that treatment (inducing cell differentiation) would also be carried out as well.

Applicant argues that Schaefer does not describe a method for treating deafness and merely lists nerve deafness as one of the neurodegenerative disorders. Applicant asserts that since Schafer and Meijer disclose different compounds that there is no motivation to combine Meijer and Schaefer. This is not found persuasive because the teaching of Schaefer is relevant in that it demonstrates the fact that nerve deafness is considered in the prior art to be a neurodegenerative disorder. Therefore one of ordinary skill in the art would consider it as a suitable disorder for treatment with the method of Meijer, which is directed to treatment of neurodegenerative disorders.

Applicant argues that Nicotera does not teach the claimed purine derivative kinase inhibitor but a protein kinase inhibitor. Applicant asserts that even if the skilled artisan would have used the protein tyrosine kinase inhibitor to treat hearing loss "in the same formats as Meijer and at the same dosage", he would not have used the claimed purine derivative kinase inhibitor in the same formats and at the same dosage, since they are and would have been perceived as different kinase inhibitors. This is not found persuasive because the teachings of Nicotera are cited to show that the skilled artisan would have had a reasonable expectation of success in applying the method of Meijer to the treatment of deafness. The fact that other kinase inhibitors had been used at the same dosage and in the same formats as that disclosed by Meijer for the treatment of deafness would have provided the skilled artisan a reasonable expectation of success in applying the method of Meijer to treat deafness as well, especially since Meijer teaches the treatment of neurodegenerative disorders.
In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986) .